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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,059	09/07/1999	VASUDEVAN PARTHASARATHY	RCA88495	8006
7590 01/06/2006			EXAMINER	
JOSEPH S. TRIPOLI PATENT OPERATIONS THOMAS MULTIMEDIA LICENSING INC. POST OFFICE BOX 5312 PRINCETON, NJ 085435312			CHANG, EDITH M	
			ART UNIT	PAPER NUMBER
			2637	

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No. 09/391,059	Applicant(s) PARTHASARATHY ET AL.	
Examiner Edith M. Chang	Art Unit 2637	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: 4,9-11 and 14-16.  
Claim(s) rejected: 1-3,5-8,12,13,18,19.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments filed on December 9, 2005 have been fully considered but they are not persuasive.

**Drawing Objections:**

**Arguments:** Applicants argue that the figures 1, 4 to 10 and 12 to 15 are not prior arts since Applicants' specification does not describe Applicants' figures 1, 4, 5, 6, 7, 8, 9, 10, 12, 13, 14 and 15 as prior art and nothing the Examiner points to in U.S. Patent No. 5,914,988 changes "this fact".

**Response:** Figures 1, 4, 5, 6, 7, 8, 9, 10, 12, 13, 14 and 15 of the current specification are disclosed and known in Application 08/629,681 filed on April 9, 1996 and then published on June 22, 1999 in U.S. Patent No. 5,914,988 (Hu et al.) by others in this country. Hence, the U.S. Patent No. 5,914,988 is 35 U.S.C. 102 prior art (MPEP 706.02 [R-3]). Therefore, the inventors' descriptions of Figures 1, 4, 5, 6, 7, 8, 9, 10, 12, 13, 14 and 15 of the current specification are prior art based on the 35 U.S.C. 102. It is the 35 U.S.C. law that changes the "this fact".

**35 U.S.C. 102(e) Rejection:**

**Argument:** Regarding independent claims 1, 5, 13 and 18, Applicants argue that the Hu et al.'s reference with Figure 1 and the details of Trellis Demapper 60 of Figure 1 in Figure 11 does not disclose the limitations of the claims.

**Response:** Claims 5 and 13 are apparatus claims of a decoder and claim 13 is the process or method claim of the apparatus. In Figure 1 of Hu et al. discloses a trellis decoder 24 comprising a DELAY element 70 for delaying received encoded symbol data (Data1 from Synchronization Control 10); a RE-ENCODER 50 for re-encoding decoded symbol representative data from Viterbi Decoder 40; and a Trellis Demapper 60 (a PROCESSOR) for demapping including processing the re-encoded symbol data from 50 and deriving decoded symbol data to Byte Assembler 90, wherein the demapper 60 (the processor) processes the re-encoded data from unit 50 & 47 (Figure 11, the detail of the demapper 60) to produce "difference data representative (X2) of a difference between successive symbols of the re-encoded symbol data: one of the successive symbols from RE-ENCODED DATA and one of the successive symbols from Delay 965 (or 975) of the RE-ENCODED DATA (FIG.11, column 13, lines 61-67), as recited in the claims".

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function.

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim (MPEP 2114[R-1]).

Therefore, Hu et al. discloses the recited apparatus and its methods in the claims.

  
**KHAI TRAN**  
**PRIMARY EXAMINER**